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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,533	02/22/2002	Linda S. Steinberg	246400.0159	7546

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EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 01/20/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/080,533

Applicant(s)

STEINBERG ET AL. *CH*

Examiner

Kathleen M Christman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

In response to the petition filed 10/15/2003 requesting withdrawal of the Statutory Invention Registration and conversion of the application to a regular utility patent. The petition was granted by Donald Hajec (Director TC 3600) in the communication mailed 11/26/2003. Originally filed claims 1-11 are pending.

#### ***Information Disclosure Statement***

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. The listing begins on page 61 of the specification.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites, "A method of designing an assessment that divides the assessment design process into a plurality of phases, and each of the phases includes objects for organizing information associated with one or more phases". It appears that the applicant is attempting to claim a method, however no method or process step appears in the claim structure. Further, the lack of a transitional phrase (i.e. consisting of, comprising) renders the claim indefinite as it is impossible to determine where the preamble ends and the claim body begins. Further the limitation "the assessment design process" lack antecedent basis. Claims 2-6, which depend from claim 1, do not clarify this issue. Particularly claim

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4 appears to modify what may be construed as the preamble of the claim, "A method". Additionally, the limitations "other products" and "other purposes" in claim 5 constitute a relative term, which renders the claim indefinite. The terms is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claim 7 similarly recites a system, which does not include a transitional phrase. Further there is no clear delineation of the claimed elements. Further the claim appears to only contain one element, "a plurality of modules". Claims 8-11 do not clarify this issue and are rejected for their incorporation of one or more of the above through their dependencies.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Sonnenfeld (US 6112149). As best understood the claims are directed to a system and method for the creation of assessments. Sonnenfeld teaches a system and method for the creation of test, quizzes, surveys, etc (see col. 2: 11-12) which are synonymous with assessments. The system and method include dividing the creation process into a plurality of phases (see col. 8: 53-60); where each of the phases include objects for organizing information associated with one or more phases (\*\*\*), as in claims 1 and 7. The phases including domain analysis, domain modeling, and conceptual assessment framework, as in claims 2 and 8) are taught as the test planning and preparation, test information, and sections for test information, respectively of the above cited section. The one or more objects including properties associated with a specific kind of assessment design information and a particular phase of the assessment design process, as in claims 3 and 9, is taught as the specific features available to the designer of the test as shown in col. 9: 8-65. The method or system being an evidence-centered design,

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as in claims 4 and 10, is taught in the abilities of the system described at col. 2: 12-15. The ability for the design components to be reused for other products, as in claim 5, is taught in the systems ability to re-use questions in a new test, see col. 9: 35-36. The process supporting model building (claims 6 and 11), storage, retrieval, and export capabilities (claim 11) is taught in col. 8: 17-45 and col. 9: 21-23.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- a. Elliott et al (US 6431875 B1) teaches an on-line test creation system
  - b. Shende et al (US 6341212 B1) teaches a test creation and distribution system and method
  - c. Fleishman (US 2003/0008270 A1) teaches a system for testing metacognitive skills
  - d. Anderson et al (US 6513042 B1) teaches a test creation system

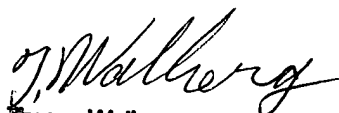
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on (703) 308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Kathleen M. Christman



Teresa Walberg  
Supervisory Patent Examiner  
Group 3700